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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,791	04/20/2001	Rocco D'Antonio	1139	2557

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EXAMINER

PASCUA, JES F

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/839,791	Applicant(s) D'ANTONIO, ROCCO	
	Examiner Jes F. Pascua	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification appears to disclose applicant's paper container being made from a grade of paper "not usable for stand along paper grocery sacks" (page 12, lines 20-21). However, the specification, as originally filed, lacks antecedence for the paper container being made from "nonpleated paper", as is now claimed. Furthermore, the original specification fails to provide support for the new recitation, "grade of paper of lighter weight than that used for standard nonpleated grocery sacks". This is a new matter rejection.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Furthermore, claims 2, 11 and 12 recite a paper liner whose base "perimeter is approximately equal to the base perimeter of the selected size plastic grocery sacks" and with "a height approximately equal to the height to the collar of the selected size plastic grocery sacks when said selected size plastic grocery sacks are opened and expanded." Plastic sacks analogous to the ones used in grocery stores are made of different base perimeters and collar heights, therefore it cannot be determined what base perimeter and collar height dimensions are required by applicant's claims. Again, it is apparent that one of ordinary skill in the art would recognize that there is some limit to the base perimeter and collar height dimensions included in these claims, but would not be able to determine, with any degree of certainty or precision, the particular limits of the base perimeter and collar height recited in the claims so as to ascertain the metes and bounds of the claims.

Claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Rodish or Fowler et al.

Applicant admits that using a paper grocery bag as a liner within a standard plastic grocery sack is old and well known. However, a paper bag whose base and height are "approximately equal" to that of an expanded "selected size plastic grocery bag" is not found. It would have been an obvious matter of design choice to make the admitted prior art paper liner with base and height dimensions that are approximately equal to a selected size plastic grocery bag (this includes those dimensions recited in claims 3-7, 10 and 14-18), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 7 and 13, the admitted prior art discloses the claimed invention, as discussed above, except for the grade of the paper bag being between 35 lbs. and 50 lbs.. Rodish teaches that it is known in the art to make grocery bags from 40 lb. paper and Fowler et al. teaches that it is known in the art to make barrel sacks from 25 lb. to 90 lb. paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the admitted prior art paper bag from the 40 lb. paper of Rodish or the 25 lb. to 90 lb. paper of Fowler et al. since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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7. Claims 2-7 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodish or Fowler et al.

Rodish and Fowler et al. each disclose the claimed invention except for the paper bags having a base and a height are "approximately equal" to that of an expanded "selected size plastic grocery bag". It would have been an obvious matter of design choice to make the paper bags of Rodish or Fowler et al. with base and height dimensions that are approximately equal to a selected size plastic grocery bag (this includes those dimensions recited in claims 3-7, 10 and 14-18), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 11, Rodish and Fowler et al. disclose the claimed invention, as discussed above, except for the paper bags being placed within the selected size plastic grocery bag. It would have been an obvious matter of design choice to place the paper bags of Rodish or Fowler et al. within a selected size plastic grocery bag, since it appears that the inventions of Rodish and Fowler et al. would perform equally well within a selected size plastic grocery bag.

Response to Arguments

8. Applicant's arguments filed 02/27/04 have been fully considered but they are not persuasive.

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The Examiner disagrees with applicant's arguments that the language "selected size plastic grocery sack" is clear. If a first plastic grocery sack and liner of a *selected size* is placed next to a second plastic grocery sack and liner of a *selected size smaller* than the first plastic grocery sack, a person having ordinary skill in the art would be unable to determine with any degree of certainty which plastic grocery sack and liner reads on applicant's claimed invention or which plastic grocery sack and liner would infringe applicant's claimed invention. The Examiner's rejection of claims 2-7 and 10-18 under 35 U.S.C. 112, second paragraph is maintained.

Regarding applicant's arguments against the Examiner's rejection of claims 2-7 and 10-18 under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Rodish or Fowler et al., it is noted that applicant does not remark that the admitted prior art is pleated or nonpleated. However, applicant argues that the Rodish reference fails to show certain features of applicant's invention. It is noted that the features upon which applicant relies (i.e., a lighter weight paper bag of standard, nonpleated construction) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant dismisses the fact that Rodish discloses making paper sacks from a grade of paper that is well within applicant's claimed range of 35 lbs. to 50 lbs. Rodish teaches using 40lb. paper. Applicant relies on the argument that Rodish teaches providing reinforcing pleats. Applicant's remarks are unfounded, since Examiner's

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rejections never suggested providing the pleats of Rodish on the admitted prior art, as purported by applicant.

Regarding the Fowler et al. patent, applicant does not deny that it discloses making paper sacks from paper of between 25 and 90 lbs (a range that overlaps applicant's claimed 35 lbs. to 50 lbs.). Furthermore, applicant recognizes that the paper sacks made by the Fowler et al. patent are not disclosed as sacks for loading with a plurality of grocery items. Applicant appears to view the paper sack of Fowler et al. as a paper container made of grade of paper of lighter weight than that used for standard paper grocery sacks and not usable for stand alone paper grocery sacks; substantially as claimed.

In response to applicant's argument that Fowler et al. does not teach lighter weight bags to be fitted into grocery bags, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant's remarks are silent with respect to the Examiner's rejection that it would have been an obvious matter of design choice to make the paper bags of the admitted prior art, Rodish or Fowler et al. with base and height dimensions that are approximately equal to a selected size plastic grocery bag.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP
April 26, 2004